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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/604,449 06/27/00 LUKENBACH

E JBP-508

EXAMINER

IM22/0814

AUDLEY A CIAMPORCERO JR
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

HARDEE, J

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

08/14/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/604,449

Applicant(s)
Lukenbach et al.

Examiner
John R. Hardee

Art Unit
1751



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) 31-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-30 and 45-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-30 and 45-49, drawn to a foaming composition, classified in class 510, various subclasses, depending on the specific ingredients.

If Group I is elected, further restriction will be required.
 - II. Claims 31-35, drawn to a method of making an oil-in-water emulsion, classified in class 252, subclass 189+.
 - III. Claims 36-40, drawn to a method of making an oil-in-water emulsion, classified in class 252, subclass 189+.
 - IV. Claims 41-43, drawn to a method of depositing a benefit agent, classified in class 510, subclass 130+.
 - V. Claim 44, drawn to a method of depositing a benefit agent, classified in class 510, subclass 510.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, inasmuch as II and III recite mutually exclusive

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steps; IV and V recite different ingredients; II and III are drawn to making emulsions, while IV and V are drawn to application of compositions; and I does not require the ingredients recited in methods II-V.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Ms. Erin Harriman on July 18, 2001 to request an oral election to the above restriction requirement resulted in the election with traverse of Group I, claims 1-30 and 45-49.

Further restriction to one of the following inventions is required under 35 USC 121:

- A. Compositions in which the water dispersible component is polyethylene glycol 400.
- ☒ B. Compositions in which the water dispersible component is hexylene glycol.
- C. Compositions in which the water dispersible component is propylene glycol.
- D. Compositions in which the water dispersible component is polypropylene glycol-10-methylglucose ether.
- E. Compositions in which the water dispersible component is ethoxydiglycol.
- F. Compositions in which the water dispersible component is polyethylene glycol-6-caprylic/capric glycerides, polyethylene glycol-6-caprylic/capric triglyceride, or polyethylene glycol-8-caprylic/capric glycerides.

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- G. Compositions in which the water dispersible component is ethylene glycol monobutyl ether.
 - H. Compositions in which the water dispersible component is triisopropyl citrate.
 - I. Compositions in which the water dispersible component is 3-methoxy-3-methyl-1-butanol.
 - J. Compositions in which the water dispersible component is dimethyl isosorbide.
 - K. Compositions in which the water dispersible component is other than those listed above. If this group is elected, a specific water dispersible component must be named. Further restriction may be required.
5. This restriction requirement is made because the groups of water dispersible components listed above are patentably distinct. A disclosure of one of these groups would not anticipate or make obvious any of the other groups.
6. Having chosen one of groups A-K, applicant is further restricted to one of the following groups:
- a. An ester as recited in part a) of claim 7.
 - b. An ester as recited in part b) of claim 7.
 - c. An ester as recited in part c) of claim 7.
 - d. An ester as recited in part d) of claim 7.
 - e. An ester as recited in part e) of claim 7.
 - f. An ester as recited in part f) of claim 7.

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g. An ester as recited in part g) of claim 7.

h. An ester other than those listed above. If this group is elected, a specific ester must be named. Further restriction may be required.

7. This restriction requirement is made because the groups of esters listed above are patentably distinct. A disclosure of one of these groups would not anticipate or make obvious any of the other groups.

8. Ms. Erin Harriman requested that the above restriction requirement be made in writing.

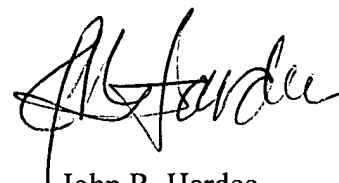
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 7:30 until 4:00. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "J. Hardee", with a stylized, cursive script.

John R. Hardee

Primary Examiner

August 10, 2001